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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,371	04/24/2001	Jean-Claude Thibault	64,149-099	5865

7590

09/26/2003

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EXAMINER

KENNY, STEPHEN

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/841,371

Applicant(s)

THIBAUT ET AL.

Examiner

Stephen J Kenny

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Finneran (US Patent No 5857579).

Regarding claim 1, AAPA discloses a method of sealing a container with a closure, said container having open distal & proximal ends, a radial rim portion surrounding said open end, a reduced diameter neck portion adjacent said rim portion and an enclosed container portion adjacent said neck portion, and a resilient stopper overlying said proximal end & said rim portion said method comprising: forming a closure having a cylindrical collar with an internal diameter slightly greater than the outside diameter of said rim portion of said container and integral rim portion; telescopically disposing said collar portion of said closure over said rim portion of said container with said radial rim portion of the closure overlying the rim portion of said container, and the cylindrical collar portion surrounding said rim of said container having a free end surrounding said reduced diameter neck portion of said container; and radially deforming the free end of the collar portion into the reduced diameter neck portion of the container beneath the rim portion, wherein the free end of the closure retains its shape following deformation to permanently retain the closure on said container and sealing said container open end (Applicant's paragraph 0003 & paragraph 0005).

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AAPA does not disclose a closure formed from a plastic polymer.

Finneran discloses a closure for a vial, which is made of plastic which is rigid enough to maintain its shape after deformation, as well as being resistant to creep (column 1, line 47; & column 11, lines 7-9 & 36-48), wherein the free ends of the collar portion (6) securely seal the closure to the container (see Figure 5). Forming a closure of plastic as disclosed by Finneran is advantageous in that it is easier to deform, and is safer to handle than metal closures. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a vial closure as disclosed in AAPA with a plastic closure as taught by Finneran in order to realize the advantages discussed above.

Regarding claim 10, AAPA discloses a medical cartridge having an open end, and filling the barrel portion with a substance & sealing said open end by inserting an elastomeric stopper (paragraph 0005).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/Finneran, as modified above as applied to claim 1 above, and further in view of Osborne (US Patent No 2409788).

Regarding claim 2, AAPA/Finneran, as modified above, disclose the claimed invention except for compressing the elastic stopper against the radial rim while simultaneously crimping the tubular collar portion.

Osborne discloses compressing the elastic stopper against the radial rim while simultaneously crimping the tubular collar portion (column 3, lines 26-40). Applying a compressive force to the elastic stopper while simultaneously crimping the tubular collar portion

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allows for a more secure/tight seal since it further displaces the stopper towards said radial rim. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a vial closure as disclosed by AAPA/Finneran while simultaneously applying a compressive & crimping force as taught by Osborne, in order to achieve a more secure/tight seal.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24 are provisionally rejected under the judicially created doctrine of double patenting over claims 1, 2, & 4-15 of copending Application No. 09/732,538 (which was allowed). This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: claims 1-24 in the present application are drawn to a method of

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incrementally sealing a container comprising an elastomeric stopper, by radially deforming a tubular collar portion via a tool having an inclined surface; all of which has been previously disclosed and claimed in the parent application 09/732,538.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

The prior art made of record on the attached PTO-892, and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J Kenny whose telephone number is 703-306-0359. The examiner can normally be reached on mon - fri 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

sk

SK
9/17/03


GREGORY VIDOVICH
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